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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,505	11/19/1999	MARIE-PASCALE AUDOUSSET	05725.0496-0	7297

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EXAMINER
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EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

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DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-19

**Office Action Summary**

Application No.

09/443,505

Applicant(s)

AUDOUSSET, MARIE-PASCALE

Examiner

Margaret Einsmann

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Applicant's remarks filed 10/5/2001 have been fully considered

***Claim Rejections***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim '438 in view of Akram. This rejection is maintained for the reasons of record in the office action of 6/29/01.

Lim, U.S. Patent No. 6,074,438, teaches and exemplifies compositions for dyeing hair which contain the oxidation base 2-chloro-4-aminophenol and a pyrazolone coupler, see Abstract and Table 1, Composition C. The exemplified composition is mixed with a hydrogen peroxide oxidant as is applied to hair as claimed, see col. 10, line 65-col. 11, line 2. Lim teaches that additional couplers may be added to the compositions in order to obtain certain color nuances and tints, including the claimed 2,6-bis(hydroxyethylamino)toluene, as well as direct dyes and additional p-aminophenol oxidation bases as claimed, see col. 5, lines 1-11 and 32-37,

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and col. 6, line 24. The additional p-amino phenol oxidative bases listed in column 5 lines 32-37 include several which are included in the claimed formula (I): 3-methyl-p-aminophenol, 2-hydroxymethyl-p-aminophenol, 2-methyl-p-aminophenol and 2-methoxymethyl-p-aminophenol. Lim teaches that the compositions may be packaged in kits as claimed, see col. 10, lines 46-54. Lim does not exemplify a composition, process or kit as claimed, particularly which contains or uses the claimed coupler, or which additionally comprises the above listed p-aminophenol oxidation bases. Akram is relied upon above as teaching that the claimed 2,6-bis(hydroxyethylamino) toluene has many improved properties when used as a coupler in hair dyeing compositions. See col 2 lines 24 et seq.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains an oxidation base and coupler as claimed, as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in kits as claimed, and is applied to hair in dyeing processes as claimed, because such compositions, processes and kits fall within the scope of those as taught by Lim. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as the additional coupler in Lim's compositions because Lim teaches the claimed coupler as being suitable for use in the patentee's compositions, and because Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties such as intense colors and resistance to various agents. Therefore, based upon Akram's teachings, those skilled in the art would have been motivated to select the claimed coupler from among those taught by Lim for use in Lim's compositions, absent a showing

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otherwise. It would have been obvious to add any or all of the claimed p-aminophenols listed in col 5 in the hair dyeing compositions as shown in order to provide a variety of shades of hair and additionally because it is notoriously well known in the hair dyeing art to combine several oxidation bases and couplers in oxidative hair coloring compositions, and the use of the additional bases and couplers falls within Lim's express teachings.

***Response to Arguments***

Applicant's arguments filed 10/2/2001 have been fully considered but they are not persuasive to overcome the above rejection. Applicant argues that there must be some suggestion in the references to modify the teachings of the references. Lim suggests the combination as claimed as he teaches that both of the components in the claimed compositions are suitable for use together in his disclosed compositions. Applicant states that Lim teaches that developers 1 and 2 may be combined with couplers 3,4 or 5. That is correct. But patentee also teaches that the claimed developer and couplers may additionally be added to the inventive composition. Patentee's composition are stated in comprising language; in no way do they exclude the additional components of Lim. It is notoriously well known that hair dyeing compositions may contain several dye bases, and Lim teaches that the two claimed dye bases are suitable for use together in oxidation hair dyeing compositions. In other words, since Lim teaches that they are compatible, they have known utility in the same process under the same process conditions. Thus Lim alone is sufficient to provide a teaching that the two claimed components are useable together in oxidative hair dyeing compositions and processes. Applicant then states that the addition of Akram to the rejection adds an additional laundry list of couplers to the choice one has in the selection of a suitable combination. The office respectfully disagrees

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with this analysis. The addition of Akram narrows the choice since Akram gives the particular motivation to select 2,6-bis(hydroxyethylamino)toluene from the list of couplers suggested by Lim in column 6 lines 17-24.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaGrange et al., US 5,703,266 and/or Clausen et al., US 4,797,130 in view of Zviak, Oxidation Coloring, Chapter 8 of The Science of Hair Care and Akram, US 5,230,710.

2. The first two references disclose the claimed compound of formula (I), a substituted paraaminophenol, and its use as a developer of oxidation base in the oxidation dyeing of hair. LaGrange et al. teach the embodiments of claimed formula (I) having the claimed R2 = to a C1-4 alkyl radical, a C1-6 polyhydroxyalkyl radical, a C2-6 alkoxyalkyl radical or an aminoalkyl radical. See the descriptive paragraph bridging columns one and two. Said substituted paraaminophenol is mixed with one or more couplers selected from metaphenylenediamines, metaaminophenols, metadiphenols and phenols. Col 1 lines 19-24. They produce colors with good resistance to light, washing, inclement weather, perspiration. The colors are substantially the same on natural and treated hair, and they are harmless. Col 1 lines 33-45. The hair treatment compositions contain conventional additives and are applied in a conventional manner as described in columns 10 and 11. They may be packaged in conventional kits wherein the oxidant is packaged separately and mixed at the time of application. See column 11. Clausen et al. teach the embodiment of the claimed formula (1) where the claimed R1 is aminomethyl. See abstract. It is also taught to be used in oxidative hair dyeing compositions in

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admixture with conventional couplers and is applied to the hair with the addition of an oxidant in the conventional manner. See columns 2-4.

Zviak is applied for his teaching that 2,6-diaminotoluene is a conventional coupler for use in oxidative hair dyeing compositions along with developers and oxidants. See Zviak pages 264-266.

Akram is applied for his teaching that 2,6-diaminotoluene is not completely satisfactory under the action of perspiration, acid rain, detergents, sunlight, UV radiation and the like and is also questionable from the toxicological point of view. Col 1 lines 36-45. Akram replaces 2,6-diaminotoluene with N-hydroxyalkyl substituted metaphenylenediamines, Akram's formula (I) in its preferable embodiment, 2,6-bis(2-hydroxyethylamino)-toluene is applicant's claimed compound 1,3-bis(beta-hydroxyethyl)amino-2-methylbenzene.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains an oxidation base and coupler as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in kits as claimed, and is applied to hair in dyeing processes as claimed, because such compositions, processes and kits fall within the scope of those as taught by La Grange and/or Clausen. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as the coupler in LaGrange's or Clausen's compositions because while Zviak teaches that 2,6-diaminotoluene is a conventional coupler in oxidative hair dyeing compositions, Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties such as intense colors and resistance

to various agents. Therefore, based upon Akram's teachings, those skilled in the art would have been motivated to select the claimed coupler in the oxidation hair dyeing compositions of Clausen or LaGrange, absent a showing otherwise.

***Response to Arguments***

Applicant's arguments filed 10/05/01 have been fully considered but they are not persuasive regarding the above rejection. Applicant argues that the combination lacks clear and particular motivation directing the artisan to choose the particular combination. Applicant argues that LaGrange does not list the coupler as claimed. However, it is within the scope of disclosed couplers formula III in col 4. Though it is not exemplified in col 5, a reference is never limited to its working examples. LaGrange discloses the mixture as claimed. Accordingly he discloses the compatibility of the two claimed components and their use in oxidative hair dyeing compositions and processes. Applicant then argues that Claussen does not teach applicant's claimed coupler. Claussen is not relied upon to teach applicant's coupler. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant claims that one of ordinary skill in the art would have several unlikely choices to make. First one would have to ignore the couplers of LaGrange and Clausen. The office respectfully disagrees with this position. La Grange teaches the coupler as claimed in combination with the developer as claimed. Claussen lists couplers which would give a red color. It is notoriously well known that one uses a wide range of couplers in the process of

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oxidative hair coloring in order to obtain a wide variety of colors. Claussen is not applied for his teaching on how to obtain a red coloration, and oxidative dyeing couplers are interchangeable absent evidence to the contrary, since they are used for the same purpose under the same process conditions, being added to form a wide variety of colors and nuances of color. It would also have been obvious to add the claimed coupler to a composition of Claussen to modify the red coloration, since applicant's claims do not exclude the couplers of Claussen.

Applicant admits that the combination of Zviak and Akram give motivation to replace 2,6-diaminotoluene with Akram's coupler but states that said coupler is not disclosed in either Claussen or LaGrange. See LaGrange, column 4, formula III when R<sub>5</sub>, R<sub>6</sub>, R<sub>8</sub> and R<sub>9</sub> are H and R<sub>7</sub> is methyl. That is 2,6-diaminotoluene. Since the combination of references gives clear suggestion to form the claimed composition, the rejection is maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/443,142. This provisional rejection is maintained for the reasons set forth in the previous Office Action, Paper #7 mailed 10/19/00. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis( -hydroxyethyl) amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts, see e.g. copending claim 1. The compositions may be used in keratin fiber dyeing processes as claimed, and may be packaged in multi-compartment kits as instantly claimed, see e.g. copending claims 26 and 31. The oxidation bases in the copending application may be p-aminophenol oxidation bases as claimed, see copending claims 11-12. The instantly claimed compositions, processes and kits are therefore obvious over the claims of the copending application, absent a showing otherwise.

Similarly, claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/443,506. This provisional rejection is maintained for the reasons set forth in the previous Office Action, Paper #7 mailed 10/19/00. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the claims of the copending application recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis( -hydroxyethyl) amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts, see e.g. copending claim 1. The compositions may be used in keratin fiber dyeing processes as claimed, and may be packaged in multi-compartment kits as instantly claimed, see e.g. copending claims 27 and 32. The oxidation bases in the copending application may be p-aminophenol oxidation bases as claimed, see copending claims 11-12. The instantly claimed compositions, processes and kits are therefore obvious over the claims of the copending application, absent a showing otherwise.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Applicant's remarks regarding the above obviousness double patenting rejections have been considered. This office notes that no allowable subject matter can be indicated while there is any rejection remaining on the claimed subject matter.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



MARGARET EINSMANN

PRIMARY EXAMINER 1751

December 17, 2001